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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,428	04/01/2004	Luc Gourlaouen	05725.1315-00	5713

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EXAMINER	
FRAZIER, BARBARA S	

ART UNIT	PAPER NUMBER
1611	

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07/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,428	GOURLAOUEN ET AL.	
	Examiner	Art Unit	
	BARBARA FRAZIER	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 April 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-69* is/are pending in the application.

4a) Of the above claim(s) *14-21,24-29 and 31-65* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9-13,22,23,30 and 66-69* is/are rejected.

7)☒ Claim(s) *7 and 8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/4/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-69 are pending in this application.

2. Claims 47-65 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/15/07.

3. Claims 14-21, 24-29, and 31-46 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/15/07.

4. Claims 1-13, 22, 23, 30, and 66-69 are examined.

Claim Rejections - 35 USC § 112

5. The rejection of claims 5 and 67 under 35 U.S.C. 112, second paragraph is withdrawn in view of Applicant's amendments to the claims.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 4, 9-13, 22, 23, 66, and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunaga et al (US 2001/0054206), as evidenced by *International Cosmetic Ingredient Dictionary and Handbook ("Handbook"),* Seventh Edition (1997), page 73.

The claimed invention is drawn to a cosmetic composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium and at least one aminosilicone, according to claim 1 (see claim 1).

Matsunaga et al discloses a composition comprising a fluorescent dye (see abstract). A silicone is added to the hair dye composition to dye the hair uniformly and have improved cosmetic effects (paragraph 24); the silicone Amodimethicone SM8702C is exemplified (see Examples 4 and 8, page 4). One skilled in the art would recognize that the "Amodimethicone" compound to be an aminosilicone; as evidence, *Handbook* discloses that Amodimethicone is an aminosilicone, used in hair dyes (see page 73). Therefore, the invention of Matsunaga et al anticipates the claimed invention.

Regarding claims 3 and 4, Matsunaga et al disclose that the compound (2) is known as C.I. Basic Yellow 2, and therefore is in the yellow range, which is 570-590 nm. This range is within Applicant's ranges of 500-650 nm (claim 3) and 550-620 nm (claim 4).

Regarding claims 9-11, Matsunaga et al disclose that the dye is preferably added in an amount of 0.01 to 20 wt.%, more preferably 0.05 to 10 wt.%, especially 0.1 to 5 wt.% (paragraph 16); this is identical to Applicant's amounts in claims 9-11.

Regarding claims 12 and 13, Matsunaga et al disclose that the silicone Amodimethicone is in the composition, which is identical to Applicant's aminosilicone of formula (A). As evidence, *Handbook* teaches the formula of Amodimethicone, which is Applicant's formula (A) (see page 73).

Regarding claims 22 and 23, Matsunaga et al disclose that the Amodimethicone is present at 1.5 to 2 wt.% (see Examples 4 and 8, page 4). This is within Applicant's ranges of 0.01 to 20% by weight (claim 22) and 0.1 to 10% by weight (claim 23).

Regarding claims 66 and 69, Matsunaga et al disclose that the hair dye composition can be prepared in a two-part composition having the dye in one part and an oxidizing agent in another part (paragraph 26).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. The rejection of claims 1-7, 9-13, 22, 23, and 30 under 35 U.S.C. 103(a) as being unpatentable over Luo et al (WO 99/13846) in view of Degen et al (US Patent 4,256,458) is withdrawn in view of Applicant's arguments, specifically that there is no motivation to combine the dye taught by Degen (used in paper) with the composition of Luo et al (used in hair care).

10. Claims 1, 9-13, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luo et al (WO 99/13846).

The claimed invention is delineated above (see paragraph 9).

Luo et al teach hair care compositions comprising an optical brightener and a silicone compound (abstract). Luo et al also teach that optical brighteners can be described by other names in the art, such as fluorescent dyes (page 3). Luo further teach that suitable silicone compounds are alkylamino substituted silicone compounds known as amodimethicones (page 19).

Luo et al do not specifically teach a fluorescent dye in combination with an aminosilicone.

However, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to select the combination of fluorescent dye and aminosilicone for the composition; thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because Luo et al fairly suggest an aminosilicone as the silicone compound, such that one skilled in the art would be able to select an aminosilicone compound from the list of silicone compounds taught as a matter of routine experimentation, with a reasonable expectation of success.

Regarding claims 9-11, Luo et al. teach that the amount of optical brightener (i.e., fluorescent dye) used is from about 0.001% to about 20%, more preferably from about 0.01% to about 10% (page 3, lines 34-36). These amounts are comparable to the amounts claimed by Applicants, especially given that the prior art uses the flexible modifier "about". One skilled in the art would be able to select optimal amounts of fluorescent dye from within said ranges as a matter of routine experimentation.

Regarding claims 12 and 13, Luo et al teach that an especially preferred amino substituted silicone the compound of formula (IV) (page 20, lines 5-20); this compound is encompassed by Applicant's aminosilicone compound of formula (A).

Regarding claim 30, Luo et al teach that the composition is a shampoo (see, for example, claims 9-14) which alters the color of the hair by emitting light in the visible range (page 3, lines 22-24).

With respect to Applicant's arguments that "[A] fluorescent dye as disclosed herein can be differentiated from an optical brightener" (page 5, paragraph), it is noted that Applicant's claims are not limited to fluorescent dyes which are also not optical brighteners. Furthermore, while the optical brighteners of Luo et al. absorb light in the range of about 200 nm and about 420 nm, they **emit** light in the range of about 400 nm and about 780 nm, and also may have minor absorption peaks in the visible range between a wavelength of about 360 nm and about 830 nm (see page 3, lines 8-21 of Luo et al.). These ranges overlap the ranges of the claimed invention, and one skilled in the art would be able to optimize such ranges as a matter of routine experimentation.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsunaga et al (US 2001/0054206) in view of Peters et al (EP-370470).

Claim 2 of the claimed invention is drawn to a cosmetic composition according to claim 1, wherein the fluorescent dye is in the orange range.

The invention of Matsunaga et al is delineated above (see paragraph 9). Matsunaga et al teach that the dye of formula (2) is also known as Basic Yellow 2 (paragraph 10).

Matsunaga et al do not specifically teach that the dye is in the orange range.

Peters et al teach fluorescent dyes for use in cosmetic compositions applied to a person's hair (abstract). The dyes may be yellow or orange, and are well known commercially available materials (col. 2, lines 30-48). Peters et al further teach that the dye(s) may be used with a carrier which is a silicone oil (col. 4, lines 35-40).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to substitute an orange dye for the yellow dye of Matsunaga et al; thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because the dye provides an aesthetically pleasing appearance to the hair, as taught by Peters et al (abstract). One would reasonably expect success from substituting the orange dye of Peters et al for the yellow dye taught by Matsunaga et al because both references are drawn to dye compositions comprising a fluorescent dye and a silicone carrier.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. **Claims 1-13, 22, 23, 30 and 66-69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 and 39 of U.S. Patent No. 7,147,673 in view of *International Cosmetic Ingredient Dictionary and Handbook ("Handbook"),* Seventh Edition (1997), page 73, or alternatively over claims 1-38 and 45 of U.S. Patent No. 7,186,278; claims 1-17 and 31 of U.S. Patent No. 7,192,454; claims 44-81 and 86 of U.S. Patent No. 7,198,650; claims 1-31 and 37 of U.S. Patent No. 7,204,860; or claims 1-41 and 48 of U.S. Patent No. 7,208,018, each in view of *International Cosmetic Ingredient Dictionary and Handbook ("Handbook"),* Seventh Edition (1997), page 73.**

The instant application is drawn to a cosmetic composition comprising, in a cosmetically acceptable medium, at least one fluorescent dye that is soluble in the medium and at least one aminosilicone, according to claim 1. Applicants have elected the species wherein the fluorescent dye is the compounds of (F3) and the aminosilicone is the compound of formula (A) as recited in claim 12.

Patent '673 (or alternatively one of the other patents listed above) claims a composition comprising, in a cosmetically acceptable medium, a fluorescent dye of formula (F1) or (F3). One skilled in the art would reasonably be able to choose the (F3) compounds from a list of just two groups of compounds by routine experimentation.

Patent '673 (or alternatively one of the other patents listed above) does not teach the presence of the aminosilicone in the composition.

Handbook teaches that the aminosilicone of formula (A) is a known cosmetic ingredient, commonly used in hair dyes (see page 73). The aminosilicone is a known hair conditioning agent (see page 73).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the aminosilicone of formula (A) to the fluorescent dye of patent '673 (or alternatively one of the other patents listed above); thus arriving at the claimed invention. One skilled in the art would have been motivated to do so because the addition of the aminosilicone would provide the dye composition with the benefit of conditioning the hair, as taught by *Handbook*. One would reasonably expect success from the addition of the aminosilicone to the dye composition of patent '673 (or alternatively one of the other patents listed above) because Handbook expressly teaches that the aminosilicone is known to be used in hair dyes.

Regarding dependent claims 2-13, 22, 23, and 30, said limitations are claimed in the dependent claims of patent '673 (or alternatively one of the other patents listed above).

Regarding claims 66-69, patent '673 claims a multi-compartment device comprising the dye composition in one compartment and an oxidizing agent in another compartment (see claim 39). This multi-compartment kit is also claimed in claim 45 of patent '278, claim 31 of patent '454, claim 86 of patent '650, claim 37 of patent '860, and claim 48 of patent '018.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

/MP WOODWARD/
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